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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,820

07/28/2003

Philip G. Wessells

20003-7015

5882

35939

7590

09/29/2004

MICHAEL E. WOODS

PATENT LAW OFFICES OF MICHAEL E. WOODS

112 BARN ROAD

TIBURON, CA 94920-2602

EXAMINER

ROYER, WILLIAM J

ART UNIT

PAPER NUMBER

2852

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,820

Applicant(s)

WESSELLS, PHILIP G.

Examiner

William J. Royer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-12 and 15-19 is/are rejected.
- 7) ☒ Claim(s) 4-6, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electrostatic transfer system of claim 2, the ink ejection system of claim 3, the thermal transfer system of claim 4, the cartridge for storing the pad of claim 5, the cartridge for adapting to a plurality of pads having different cross-sectional areas of claim 6, the transfer media secured using semi-tacky adhesive disposed between successive edges of the transfer media of claim 9, the transfer media secured using an adhesive adhered to a plurality of side edges of the media of claim 10, the transfer engine including an aperture for ejecting ink of claim 12, the mechanism which ejects the removed transfer medium of claim 14 and the transfer media being detached from the pad of claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to because of the following informalities:

Figure 2 is objected to because every line is not durable, clean, black, sufficiently, dense and dark, and uniformly thick and well defined. It is noted that most of Figure 2 is black and the details that are intended to be shown cannot be seen because of the quality of the figure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

On page 1, line 7, change "_____" (20003-7003) to --- 10/628,749 ---.

On page 1, line 8, change "TRANSFER" to --- PRINTING ---.

On page 1, line 8, change "_____" (20003-7010) to --- 10/628,750 ---.

On page 1, line 9, change "PRINTER" to --- PAD PRINTING ---.

On page 2, line 1, after "page to" insert --- be ---.

On page 4, lines 10 and 15, after "view" insert --- of ---.

On page 4, line 16, change "for a pad transfer system 100" to --- for a pad transfer system 100 (e.g., image transfer system or image transfer apparatus) --- in order to provide proper support for the language used in the claims.

On page 4, line 16, change "Transfer system" to --- Pad transfer system ---.

On page 5, lines 12, 16, 20 and 23, change "printing system 100" to --- transfer system 100 ---.

On page 6, line 4, change "Access port" to --- Image access port ---.

On page 6, line 11, before "system" insert --- pad transfer ---.

On page 6, line 15, after "through" insert --- image ---.

On page 6, line 18, change "Print" to --- Transfer ---.

On page 6, line 22, change "etc." to --- and the like ---.

On page 7, line 12, after "pad" insert --- 120 ---.

On page 7, line 13, change "print" to --- transfer ---.

On page 8, line 2, change "printing" to --- transfer ---.

On page 8, lines 4 and 9, is the reference to "Figure 1" correct or should "Figure 1" be changed to --- Figure 2 ---?

On page 8, line 10, after "pad transfer system" insert --- 100 ---.

On page 8, line 10, before "access" insert --- image ---.

On page 8, line 13, after "engine" insert --- 110 ---.

On page 13, line 7, change "the transfer engine" to --- a transfer engine ---.

On page 13, line 8, change "a transfer engine" to --- the transfer engine ---.

Appropriate correction is required.

Claim Objections

Claims 1, 6 and 13-15 are objected to because of the following informalities:

Claim 1, lines 3-4, delete --- and coupled to said transfer engine ---.

Claim 1, line 5, after "housing" insert --- and coupled to said image capture system ---.

Claim 1, line 9, before "registration" insert --- medium ---.

Claim 6, line 2, before "registration" insert --- medium ---.

Claim 13, line 2, before "registration" insert --- medium ---.

Claim 13, line 3, change "medium" to --- media ---.

Claim 14, line 2, before "registration" insert --- medium ---.

Claim 14, line 2, change "medium" to --- media ---.

Claim 15, line 1, change "transfer image" to --- transfer engine ---.

Appropriate correction is required.

Claims 7-10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 7-10 are directed towards an image transfer system but recite no structure to further limit the image transfer system. Instead the applicant has recited limitations directed towards the transfer medium. The actual transfer medium is not part of the invention since it is recited in a "for use" statement. It is noted that intended use statements are not given any patentable weight in an apparatus claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-12 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Saka (JP 09-058073). In regards to claims 1-3, 7-12 and 19, Saka discloses an image transfer system, image transfer apparatus or printer that includes a housing 1, an image capture system 2, 5, 102 for storing and producing an image, a transfer engine 214 within the housing for transferring the image to a transfer medium located at a transfer position and a transfer medium registration system 400, 401, 304 for positioning a pad including a plurality of transfer media releasably secured to one another. Further, it is disclosed that the transfer engine 214 includes an ink jet head. Claims 7-10 are rejected since the applicant has not recited any structure in these claims with respect to the image transfer system. In regards to the image transfer

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method of claims 16-18, Saka discloses a method including the steps of a user providing data such as a graphic form and an alphabetic character via a keyboard which can be stored or captured in RAM, flash ROM and the like; positioning a pad 10 including a plurality of transfer media 12 releasably secured to one another at a transfer position and transferring an image to one of the transfer media positioned in the transfer position. Further, it is disclosed that a user can remove one of the plurality of media and stick the media in a desired location after the media has received an image.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 16 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27 and 28 of copending Application No. 10/628,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending

Application No. 10/628,749 claims an image transfer apparatus including: a housing; a transfer engine; and a transfer medium registration system wherein the transfer medium registration system and the transfer engine are integrated with an imaging system in claim 27 and claim 28 which depends from claim 27 defines the imaging system as being an image capture system. Consequently, claims 27 and 28 of copending Application No. 10/628,749 define all of the features claimed in claims 1, 16 and 19 with the method of claim 16 being inherent based upon the disclosed apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 4-6, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Relevant Prior Art

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alt discloses a sheet feeder for printing bound sheets.

Crandall et al disclose a preprinted back sheet template for holding sheets from a pad of notes so that the sheets can be fed through a printer.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Royer whose telephone number is (571) 272-2140. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur T. Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "William J. Royer". The signature is fluid and cursive, with the first name "William" and last name "Royer" clearly distinguishable.

William J. Royer
Primary Examiner
Art Unit 2852

wjr
September 28, 2004